

REMARKS

I. Status of the Claims

Claims 27-83 are pending in the present application. Claims 27, 28, 35, 43, 57, 64, and 80-83 have been amended to more particularly describe what the Applicant considers to be the invention. Claims 42 and 54 have been amended to correct minor typographical errors. Support for amended claim 27 can be found on pages 9 and 11 of the specification, for example. Support for amended claims 28 and 35 can be found on page 8 of the specification, for example. Support for amended claim 43 can be found on page 12, for example. Support for amended claim 57 can be found on page 14, for example. Support for amended claim 64 can be found on page 15, for example. Support for amended claim 80-83 on pages 7, 8 and 17 of the specification, for example. Accordingly, no new matter has been added by the foregoing amendments.

II. Interviews and Information Disclosure Statement

Applicant thanks the Examiner for the personal interview and for the telephonic interview indicating which claims he viewed as being improper under 35 U.S.C. § 112 second paragraph. Applicant notes that the telephonic Interview Summary was dated September 10, 2003 although the telephonic interview occurred on October 9, 2003.

Applicant also thanks the Examiner for signaling his consideration of document number 8 of the IDS.

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III. Claim rejections under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 27-83 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Office Action p. 2. Applicant respectfully traverses.

A. Alleged indefiniteness of "derivative"

The Examiner has narrowed this rejection by alleging that the combined phrases "protein derivatives" "and derivatives thereof" are indefinite. *Id.* at page 3. Although Applicant respectfully traverses this rejection for at least the reasons of record, the amendments to claims 28 and 35 render this rejection moot.

B. Alternative listings and Markush groups

The Examiner alleges that "[s]everal of the claims contain improper alternative groupings that should be corrected." Office Action at page 2. In particular, the Examiner notes that "and" is used several times in a single group listing alternative limitations (e.g., claim 28). The Examiner has indicated that claims 28, 43, 57 and 64 are allegedly indefinite. Although Applicant respectfully traverses this rejection for at least the reasons of record, the amendments to claims 28, 43, 57 and 64 render this rejection moot.

Next, the Examiner suggests that "applicants insert --the group consisting of-- after chosen from." *Id.* The portion of the MPEP cited by the Examiner merely recites suitable examples of proper claim language, and these examples are by no means exclusive. *Id.* The Examiner also asserts that "chosen from" is open language, and as such is not proper for use in an alternative listing. *Id.* at page 8 paragraph 8. Respectfully, the Examiner is improperly interpreting the phrase "chosen from." The

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words of a claim must be given their "plain meaning" absent a definition in the specification. MPEP 2111.01; *In re Zletz*, 893 F.2d 319 (1989). Using standard English, "chosen from" plainly means that selection occurs from the list following the words "chosen from." Respectfully, it is improper for the Examiner to twist common sense, plain meanings of the English language to reject claims as indefinite. Finally, Applicant's note that the "chosen from" language is found in claims of issued patents, as exemplified by issued US Patents 6,589,519, 6,599,328, and 6,589,538 (copies of which are enclosed for Examiner's convenience). For at least these reasons, Applicant respectfully requests withdrawal of this rejection.

IV. Claim rejections under 35 U.S.C. § 103(a)

The Examiner has rejected claims 27-83 over WO 97/17055 (as represented by Roulier et al. U.S. 6,045,814 ("Roulier")) in view of Roulier et al. U.S. 6,280,750 ("Roulier II") for the reasons set forth on pages 3-6 of the Office Action. By submitting a certified translation of the French language foreign priority, Applicant has perfected the foreign priority pursuant to 35 U.S.C. §§ 119(a), 365(b) and 365(c). As such, *Roulier II* is now unavailable as prior art, thereby rendering this rejection moot. Withdrawal of this rejection is respectfully requested.

The Examiner also rejects claims 27-83 over *Roulier* in view of Intercos Italia S.p.A. EP 0,803,245 A1 ("EP '245") for the reasons set forth on pages 6-7 of the Office Action.

The Examiner argues that it is *prima facie* obvious to combine two or more ingredients that have previously been used separately for the same purpose in order to

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form a third composition useful for that same purpose. Office Action page 7. This is an improper application of this type of rejection, at least because *Roulier* produces its gels using an extrusion method (abstract, column 1 lines 5-9, 17-20; column 2 lines 5-13, and 54-57; column 8 lines 21-50; column 10 lines 2-14) whereas EP '245 manufactures the gel using a casting method (column 1 lines 46-48). *Roulier* states that "it was not possible to manufacture [their] aqueous solid gels using ... casting." Column 2 lines 5-7. The Examiner has provided no evidence that the gel-making technique used by EP '245 could be used by *Roulier*. Therefore, absent any evidence to the contrary, these ingredients could not be used for the same purpose because the gel-making techniques using the different gelling ingredients were not compatible. Finally, at least because the Examiner has provided no motivation as to why one of ordinary skill in the art at the time the invention was made would have substituted one gel-making technique for the other, and for the reasons already of record, Applicant respectfully requests that this rejection be withdrawn.

Further, the Examiner also appears to be relying on the substitution of equivalents which are known for the same purpose. See Office Action page 7. This is also improper. To rely on the rationale of equivalents known for the same purpose in an obviousness rejection, "the equivalency must be recognized in the prior art, and cannot be based ... on the mere fact that the components as issue are functional ... equivalents." MPEP 2144.06 citing *In re Ruff* 256 F.2d 590 (CCPA 1958). Here, the Examiner has not pointed to anything in the prior art that makes gellan equivalent with the other gelling agents. Also, gellan is not mentioned as a gelling ingredient in the

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extrusion method of *Roulier* and thus this further demonstrates that the Examiner has provided no evidence that gellan is equivalent to the other gelling agents.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: November 3, 2003

By:



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Harry J. Guttman  
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Attachments:

- Certified Translation of French Patent Application No. FR 2 795 080
- Copy of U.S. Patent Nos. 6,589,519, 6,599,328 and 6,589,538

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